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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,416	04/19/2002	Denise Renee Murray		9178

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EXAMINER

KING, ANITA M

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,416

Applicant(s)

MURRAY, DENISE RENEE

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is the second office action for application number 10/043,416, Edge-It, filed on April 19, 2002.

Inventorship

The request to correct the inventorship of this nonprovisional application under 37 CFR 1.48(a) is deficient because:

It lacks the required fee under 37 CFR 1.17(i).

Drawings

The drawings were received on April 18, 2003. These drawings are approved.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "10," "12B," "21," and "23". A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The substitute specification filed April 18, 2003 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following titles are suggested examples: --Forearm Edge Support-- or --Forearm Edge Rest--.

The use of the trademark PLEXIGLAS has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no antecedent basis in the specification for the terms "two arms and a base," in claim 2, line 1; "acrylic," in claim 3, line 1 and in claim 6, line 1; and "chamfered," in claim 4, line 2.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-6 have been renumbered as claims 2-7. Applicant's cancellation of claims A-H has been noted however, the previous number given to the claim was number 1 and thus, claim 1 has been canceled and claims 2-7 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "tilted" in line 1 of claims 2 and 6 is new matter. The original specification refers to the device as being a U-shaped solid channel having a tapered height. The specification does not state that the device is a tilted device nor does it define what is meant by the word "tilted".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the U" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the U channel" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,554,039 to James. James discloses a tilted U-shaped device (10) having two arms (11) and a base formed from a channel of plastic (Col. 1, line 44ff), which channel exteriorly covered with a layer of padding (12); the device being capable of fitting over the edge of a table; and wherein the opening at the front of the U-shaped device is narrower than the opening at the base to provide a friction fit over an edge of an object, such as a table.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over James. James further discloses that the channel has a predetermined length, the channel is constructed from a lightweight plastic, and the padding is constructed of foamed material covered by a fabric material and that wherein the opening at the front of the channel is less than the width of the opening between the two arms. James discloses the claimed invention except for the limitations of the plastic of the channel being acrylic, the channel being eight inches long, and the padding being neoprene.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of the channel in James to have been acrylic and to have modified the padding in James to have been neoprene for the purpose of providing the device with an alternative clear rigid plastic channel and an inexpensive synthetic rubber padding and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

It would have been an obvious matter of design choice to have modified the length of the channel in James to have been eight inches long, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over James in view of U.S. Patent 4,089,497 to Miller et al., hereinafter, Miller. James discloses the claimed invention except for the limitation of the arms being chamfered at the ends of

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the arms. Miller teaches that it is known in the U-shaped padded device art to have a device comprising a U-shaped channel (17) having chamfered ends (@ 38 & 40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the ends of the channel in James to have been chamfered as taught by Miller for the purpose of preventing the padding (12 & 13) from being torn by the ends of the channel currently disclosed by James.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,710,992 to Falwell et al.

U.S. Patent D463,170 to Schultz

U.S. Patent 6,467,737 to Dorantes

Falwell et al. disclose a padded rail cap having a channel. Schultz discloses a worksurface edge piece. Dorantes discloses an adjustable armrest having a channel member for attaching to an edge of a table.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.


Anita M. King
Primary Examiner
Art Unit 3632

August 21, 2003